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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/328,626 06/09/99 BOVE

S 245-111

000570 TM02/1023
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103

EXAMINER

FELTEN, D.

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/328,626

Applicant(s)
Bove et al

Examiner
Daniel Felten

Art Unit
2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 9, 1999
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Applicant(s): Bove et al. (705/36)
Representative: Jablon ()

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fidelity Investments (Herein referred to as 'FI'), Portfolio SelectorSM (Website: http://personal100.fidelity.com/planning/investment/content/building_your.htm.)

FI discloses a computerized process and product for automating and executing investment planning for a client (see, FI's, Portfolio SelectorSM Demo, Overview) comprising:

(a) inputting into a computer data regarding the client's desired asset portfolio (see Portfolio SelectorSM Demo, Build a Profile), as in (b)...desired allocation (see Portfolio SelectorSM Demo, Asset Mix), as in (d)...to automatically generate financial transactions with recommendations for modifying the clients current asset portfolio to reach as close as possible

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1 to the desired asset allocation and preferred domain (see Portfolio SelectorSM Demo, *Asset Mix*
2 and *Model Portfolio*), as in (c)... preferred domain (see Portfolio SelectorSM Demo, *Build a*
3 *Profile*), as in (e) displaying the recommendations on a summary report for review by the
4 client or the client's financial manager (see Portfolio SelectorSM Demo, *Model Portfolio*)

5 FI fails to disclose a computer program product including at least one computer
6 readable medium. Computer readable medium (i.e., IC cards, floppy disks, or compact discs,
7 software packages, etc..) are commonly used in the art to download various computer
8 programs onto computer hard drives for either individual "stand alone" usage, or in
9 conjunction with a network such as the Internet (i.e., American On-line software) . Therefore
10 it would have been obvious for an artisan of ordinary skill at the time of the invention to
11 employ the use of a computer readable medium to store the program and to be later
12 downloaded onto a computer system. The computer medium would have provided a
13 convenient means to physically transport software from computer to computer. Thus to
14 provide a computer medium with the FI program would have been an obvious expedient well
15 within the ordinary skill in the art.

16 FI fails to give recommendations for selling amounts of selected current assets.
17 However, since FI does rate investment performances and expenses, it would have been
18 obvious for an artisan at the time of the invention to provide a sell indicator which would alert
19 the investor of a below average or poor investment, because such a modification as an artisan

1 at the time of the invention would recognize that sell indicators are commonly used in the
2 trading of commodities in order to protect investors against losses. Thus such a modification
3 would be an obvious expedient to one of ordinary skill in the art.

4
5 ***Conclusion***

6
7 3. Any inquiry concerning this communication or earlier communications from the examiner
8 should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The
9 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
10 Any inquiry of a general nature relating to the status of this application or its proceedings should
11 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
12 ***Vincent Millin*** whose telephone number is (703) 308-1065.

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16 4. Response to this action should be mailed to:

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18 Commissioner of Patents and Trademarks

19 Washington, D.C. 20231

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21 for formal communications intended for entry, or (703) 305-0040, for informal or draft
22 communications, please label "Proposed" or "Draft".

23 Communications via Internet e-mail regarding this application, other than those under 35
24 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be

1 addressed to [daniel.felten@uspto.gov].
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5 All Internet e-mail communications will be made of record in the application file. PTO
6 employees do not engage in Internet communications where there exists a possibility that
7 sensitive information could be identified or exchanged unless the record includes a properly
8 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
9 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
10 Trademark on February 25, 1997 at 1 195 OG 89.
11

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13 

14 Daniel S. Felten
15 October 17, 2001

F Poinvil
FRANTZY POINVIL
PRIMARY EXAMINER

AU 2165